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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,660	12/08/2000	Haruhiko Kouhara	038602/1023	1711

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EXAMINER
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HUTSON, RICHARD G

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/731,660

Applicant(s)

KOUHARA ET AL.

Examiner

Richard G Hutson

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 2,11-13,20,21 and 23.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 4-6,22 and 24-29.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_



Richard G Hutson, Ph.D.  
Primary Examiner  
Art Unit: 1652

Continuation of 2. NOTE: Applicants proposed amendment to the claims will not be entered because it introduces new issues and would require additional search after-final rejection. These include applicants proposed amendment to claims 4, 25 26 27, 28 and 29 reciting "wherein said probe binds to a DNA molecule or an RNA molecule encoding FRS2 polypeptide" which would result in at the very least an objection to "FRS2 polypeptide" as made previously. Similarly applicants proposed amendment of claim 26 is drawn to "FRS2 polypeptide" as previously discussed. Applicants proposed amendment of claim 37 reciting "has Grb-2 binding activity" is unclear in that it is not clear what such an activity entails as it is at least unclear what Grb-2 is. Further applicants proposed amendment of claim 29 introduces a number of the above issues, as well as a genus that has not yet been considered or searched. Specifically applicants introduction after-final of the genus of nucleic acid probes encoding a "FRS2 polypeptide having the amino acid sequence set forth in SEQ ID NO: 1 except that it lacks at least one, but not all, of the specified domains, and contains a mutation of one or both tyrosine 349 and tyrosine 392 has not previously been considered.

Continuation of 5. does NOT place the application in condition for allowance because: The rejections of record remain in light of the non entry of applicants amendment.

With respect to applicants traversal of the rejection of claims 4-6, 22, 24 and 25-29 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, applicants proposed amendment if entered changing the claims from "nucleic acid probe comprising" to "nucleic acid probe consisting" does not affect the claim because the claims in question further recite encodes a polypeptide comprising at least 10 contiguous amino acids..." and thus applicants attempt to "close" the language of the claim does not in fact result in such.

With respect to applicants traversal of the rejection of claims 4-6, 22, 24 and 25-29 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid encoding a FRS2 polypeptide, wherein said FRS2 polypeptide has the amino acid sequence of SEQ ID NO: 1, does not reasonably provide enablement for any nucleic acid encoding any FRS2 polypeptide, as discussed above, applicants proposed amendment if entered changing the claims from "nucleic acid probe comprising" to "nucleic acid probe consisting" does not affect the claim because the claims in question further recite encodes a polypeptide comprising at least 10 contiguous amino acids..." and thus applicants attempt to "close" the language of the claim does not in fact result in such.